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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,555	11/20/2003	David Joseph Preskar	241574US26	5686

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3781

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/716,555

Applicant(s)

PRESKAR ET AL.

Examiner

Anthony D. Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5-29,31-33 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,12,13,15-17,21-24,26 and 29-37 is/are rejected.
- 7) ☒ Claim(s) 9-11,14,18-20,25,27,28,38 and 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Dixon 5,544,431. Dixon '431 discloses all the limitations of the claims including the following: an athletic shoe 10; a sole assembly 18; a cushioning arrangement 24, 30, 32, 34, 50, 42, 28, 52 disposed within said sole assembly; the cushioning arrangement including at least two cushioning elements 28, 30, 32, 34; a first of the cushioning elements disposed on a medial side of said shoe in a heel region of said shoe (see Figures 1-3) and a second of the cushioning elements provided on a lateral side of said shoe in said heel region (see Figures 1-3); a stiffening spring 24, 38, 42 at least partially surrounding each cushioning element; said stiffening spring having a stiffness greater than each cushioning element (supports the compression of each cushioning element); a central cushioning arrangement 50, 52 disposed in a central portion of said heel region (see Figure 3); the central cushioning arrangement including a plurality of cushioning ribs 50, 52 spaced apart from each other in a lengthwise direction of the shoe (see Figure 2, forward end of 50 is one rib, near front of heel, rearward end of 50 is another rib that are spaced lengthwise of the shoe, from each other) and extending in a widthwise direction of said shoe (see Figure 2); a first set of cushioning elements 28, 30 disposed between said first cushioning arrangement and said central cushioning arrangement, and a second set of cushioning elements 32, 34 disposed between said second cushioning arrangement and said central cushioning arrangement.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen 5,203,095 in view of Jacinto 4,592,153. Allen '095 discloses the limitations as follows: a sole assembly 10; a cushioning arrangement 114, 116, 130 disposed within said sole assembly; at least one cushioning element 130; a stiffening spring 114, 116 at least partially surrounding the at least one cushioning element; the stiffening spring has a stiffness greater than the at least one cushioning element (see col. 4, line 63- col. 5, line 25), a portion of said at least one cushioning element is disposed adjacent to a periphery of said shoe (see Figure 4) and said stiffening spring at least partially defines an aperture (see Figure 4, spring 114, and 116 defines aperture); the at least one cushioning element is disposed in said aperture such that said at least one cushioning element can be seen and touched from an exterior of said shoe (see Figure 4). Allen '095 does not disclose a plurality of cushioning elements in the aperture and space that can be seen and touched from an exterior of the shoe provided between adjacent ones of the first plurality of elements. Jacinto '153 teaches that a spring in the heel of a shoe can have a plurality of cushioning element 25, 33, 35, 27 located in the aperture formed by the spring to aid in cushioning the impact of the user's foot with the ground. Furthermore, Jacinto '153 teaches that space, filled with a cushioning material 37, can be provided between the cushioning elements to provide the sensation of buoyancy as well as aid in the provision of optimal response for an individual user. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place multiple cushioning elements in the aperture of the spring of Allen '095, as taught by Jacinto '153, to allow for better cushioning distribution and to also place space, either filled or unfilled, as taught by Jacinto '153, to aid in fine tuning the

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response for the individual user. With respect to the limitation that the space be seen and touched from the exterior of the shoe, when the shoe is put together, this space can be seen and touched from the exterior of the shoe, therefore, it would meet this limitation in the claim.

5. Claims 5-7, 21, 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above in view of Lombardino 6,751,891. The references as applied to claim 1 above disclose all the limitations of the claims except for the positioning of the plurality of cushioning elements. Lombardino '891 teaches that a cushion located within the sole can include multiple cushioning elements 24 with a stiffer spring 50 located around the cushioning element to give a stiffer cushioning to the element. Lombardino also teaches that the cushioning element can be made of six elements with spaces located between the elements, located laterally of each other and extending, staggered, from the lateral side of the element to the medial side of the element (see Figure 6). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the cushioning element with multiple cushioning elements spaced apart and across the sole of the shoe, as taught by Lombardino '891, to allow for flexibility in the cushioning of the impact of the user's foot with the ground.

6. Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 7 above in view of Preman et al. 5,224,280. The references as applied to claim 7 above disclose all the limitations of the claims except for the stiffening spring having a curved top disposed above the first plurality of cushioning elements. Preman et al. '280 teaches that the top wall 13 of a stiffening spring 4 can be curved to help absorb the impact of the user's foot with the ground. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the top wall of the stiffening spring of the references as applied to claim 7 above curved, as taught by Preman et al. '280, to aid in cushioning the impact of the user's foot with the ground.

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7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 12 above in view of Dixon 5,544,431. The references as applied to claim 12 above disclose all the limitations of the claims except for the central cushioning arrangement including a plurality of ribs extending in a widthwise direction of the shoe. Dixon '431 teaches that a central cushioning arrangement can have ribs 52 extending in a widthwise direction to aid in cushioning the impact of the user during use as well as to keep the other cushioning elements supported in a vertical manner. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a central cushioning arrangement with widthwise extending ribs, such as that taught by Dixon '431, in the central area of the cushioning arrangement of the references as applied to claim 12 above, to aid in cushioning the impact of the user's foot with the ground as well as support the other cushioning elements.

8. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above in view of Preman et al. 5,224,280. The references as applied to claim 1 above disclose all the limitations of the claims except for the stiffening spring having a curved top disposed above the first plurality of cushioning elements. Preman et al. '280 teaches that the top wall 13 of a stiffening spring 4 can be curved to help absorb the impact of the user's foot with the ground. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the top wall of the stiffening spring of the references as applied to claim 1 above curved, as taught by Preman et al. '280, to aid in cushioning the impact of the user's foot with the ground.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 16 above in view of Dixon 5,544,431. The references as applied to claim 16 above disclose all the limitations of the claims except for the central cushioning portion in the heel with ribs. Dixon '431 teaches that a central cushioning arrangement can have ribs 52 extending in a widthwise direction to aid in cushioning the impact of the user during use as well as to keep the other cushioning elements supported in a vertical manner. Therefore, it would have been obvious, to one of ordinary skill in the art at the time

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the invention was made, to place a central cushioning arrangement with widthwise extending ribs, such as that taught by Dixon '431, in the central area of the cushioning arrangement of the references as applied to claim 16 above, to aid in cushioning the impact of the user's foot with the ground as well as support the other cushioning elements.

10. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 22 above in view of Preman et al. 5,224,280. The references as applied to claim 22 above disclose all the limitations of the claims, including the first and fifth assemblies having similar stiffness (made of same size, shape and material) but do not teach the stiffening spring having a curved top disposed above the first plurality of cushioning elements. Preman et al. '280 teaches that the top wall 13 of a stiffening spring 4 can be curved to help absorb the impact of the user's foot with the ground. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the top wall of the stiffening spring of the references as applied to claim 22 above curved, as taught by Preman et al. '280, to aid in cushioning the impact of the user's foot with the ground.

11. Claims 29, 31-33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 21 above in view of Dixon 5,544,431. The references as applied to claim 21 in view of Preman et al. 5,224,280 and Cheng 6,477,789. The references as applied to claim 21 above disclose all the limitations of the claims including the hour-glass shape (see Lombardino '891, Figure 10), the cushioning elements being truncated cones (again, see Figure 10 of Lombardino), but does not teach the top of the stiffening spring being curved and the space that can be seen and touched from an exterior of the shoe being provided between adjacent ones of plurality of cushioning elements. Preman et al. '280 teaches that the top wall 13 of a stiffening spring 4 can be curved to help in absorbing the impact of a user's foot with the ground. Therefore, it would have been obvious to make the top wall of the stiffening spring of the references as applied to claim 21 above, curved to aid in cushioning the impact of the user's foot with the ground. Dixon '431 teaches that the cushioning elements can have spaces between them to

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allow for the distribution of the forces of the impact of the user's foot with the ground. these spaces can be seen and touched from an exterior of the shoe during the manufacturing process of the shoe and therefore meet this limitation in the claim. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to spread out the cushioning elements of the references as applied to claim 21 above, to aid in distributing the force of the impact of the user's foot with the ground.

***Allowable Subject Matter***

12. Claims 9-11, 14, 18-20, 25, 27-28, 38 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

13. Applicant's arguments filed August 16, 2006 have been fully considered but they are not persuasive. Applicant argues that none of the references teach "a space" that "can be seen or touched from an exterior of said shoe". This limitation is addressed in the rejections set forth above. Specifically, applicant has failed to place a time frame in which this space can be seen and touched, i.e. after the shoe is put together, or by the user of the shoe while wearing it etc. Since there is no time frame established for the space and the seeing and touching of the space, during the manufacturing process, when the shoe is being put together, the space of the above applied references can be seen and touched from an exterior of the shoe, i.e. when placing the parts of the shoe together. With respect to applicant's arguments that Lombardino does not teach cushioning assemblies adjacent on a lateral side of each other, this argument is also not convincing. Although staggered, the assemblies of Lombardino can be considered to be adjacent to each other since the term adjacent, in its broadest reasonable interpretation, means "near". The assemblies in Lombardino meets the "near" interpretation of adjacent.



***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

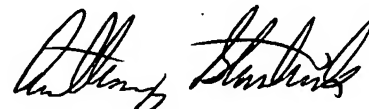
15. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday, 8:00 am until 4:00 pm.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony Stashick  
SPE  
Art Unit 3781

ADS